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10/774,343

02/05/2004

Michael Landau

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EXAMINER

SHAW, PELING ANDY

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/774,343	<b>Applicant(s)</b> LANDAU ET AL.	
	<b>Examiner</b> PELING A. SHAW	<b>Art Unit</b> 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/17/2008 has been entered. Claims 1, 13 and 27 are amended. Claim 39 is new. Claims 1-39 are currently pending.

2. Amendment received on 03/05/2008 was entered into record. Claims 6, 20 and 32 were amended.

### ***Priority***

3. This application has no priority claim made. The filing date is 02/05/2004.

### ***Claim Rejections - 35 USC § 112, first paragraph***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 39 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the original specification and claims in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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- a. Claim 39 recites the limitations of “wherein the permission spectrum has a first limit, a second limit, and an intermediate gradient between the first limit and the second limit, such that: the entity sends unlimited information to an email address that is fit at the first limit; the entity sends no information to an email address that is fit at the second limit; the entity sends limited information to an email address that is fit within the intermediate gradient, wherein the limited information is derived based on the processed contextual information” that are not found in the original specification or claims. Although the amended changes seem to be irrelevant to the application and to the applying of prior arts in the following rejection, these changes still modify the scope of the invention and introduce new subject matter into the application. It would require undue experimentation for one of ordinary skill in the networking art at the time the invention was made to be able to add and test all these functions inclusively rather than just pick a particular function for implementation. Claim 39 is thus rejected. For the purpose of applying art, the limitations are read in light of Fig. 1 and 5<sup>th</sup> paragraph on page 9 through 2<sup>nd</sup> paragraph on page 10 of applicant’s specification.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki (US 7224778 B2), hereinafter referred as Aoki and in view of Tripp (US 20050015466 A1), hereinafter referred as Tripp.

- a. Aoki shows (claim 1) a method for managing opt-out or unsubscribe information (Fig. 1, item 42; column 5, line 40-column 6, line 3: double opt-out confirmation on canceling subscription) comprising collecting an e-mail address and contextual information for a user (column 5, lines 27-39: listing of approved message sources maintained for each individual destination user address along with predetermined parameters); storing the e-mail address and contextual information in a database (column 5, lines 11-26: subscription database); processing the e-mail address and contextual information for rule-based and learning-based use (column 4, lines 45-54: filter rules provided; column 3, line 32-65: complete subscription agreement on a visit to a web site; Fig. 3, items 104, 114, 116, 38 and column 6, lines 4-26: new subscription upon a message not part of any authorized subscription; 1<sup>st</sup> paragraph on page 7 of applicant's specification); and distributing or sharing the e-mail address and contextual information, and derived processed data to an entity entitled to such information, at intervals or upon request (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating approved list; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users; column 5, lines 27-39: controlled or periodically updated). Aoki does not explicitly show (claim 1) processing the contextual information corresponding to the e-mail address to fit the e-

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- mail address within a permission spectrum based on the processed contextual information; and the entity sends information to the e-mail address based on the permission level indicated by the permission spectrum.
- b. Tripp shows (claim 1) processing the contextual information corresponding to the e-mail address to fit the e-mail address within a permission spectrum based on the processed contextual information; and the entity sends information to the e-mail address based on the permission level indicated by the permission spectrum (in light of Fig. 1 and 5<sup>th</sup> paragraph on page 9 through 2<sup>nd</sup> paragraph on page 10 of applicant's specification; paragraphs 96-98: dynamic rating/ranking based on contextual information for web pages opt-in/opt-out request via email) in an analogous art for the purpose of peer-to-peer automated anonymous asynchronous file sharing.
- c. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify Aoki's functions of using a rules model to improve handling of personally identifiable information with Tripp's functions of dynamic rating/ranking of searched contextual information for opt-in/opt-out information request.
- d. The modification would have been obvious because one of ordinary skill in the art would have been motivated to further incorporate rating/ranking functions as per Tripp's teaching in the general art of identifying and filtering contextual information as per Aoki (column 1, lines 32-56) and Tripp (paragraph 96)'s teaching.
- e. Regarding claim 2, Aoki shows wherein the act of collecting opt-out or unsubscribe e-mail information includes: input from a plurality of sources, including HTML form

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- inputs, HTTP links, bulk text-file import, or other input mechanisms (column 3, lines 30-65: World Wide Web site and email; column 6, lines 35-42: Web page, email).
- f. Regarding claim 3, Aoki shows further including: configuring the act of collecting opt-out or unsubscribe e-mail information (column 6, lines 35-42: subscription manager and associated database automatically assures coordinated update, messaging among service provider, partner and subscriber).
- g. Regarding claim 4, Aoki shows further including: selecting a distribution method from a plurality of methods including File Transport Protocol (FTP), E-mail, Hypertext Transfer Protocol (HTTP), Graphical User Interface (GUI), or other network transport mechanism (column 3, lines 42-51: service provider provide subscription-type message; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users; column 6, lines 35-42: Web page, email).
- h. Regarding claim 5, Aoki shows further including: utilizing the database and processing mechanisms to conform to legal standards or best practices for e-mail marketing (column 1, lines 32-39: legitimate subscription-type messages; column 3, lines 4-21: legitimate recurring messages; column 5, lines 11-26: subscription database; line 40-column 6, line 3: double opt-out confirmation on canceling subscription; column 6, lines 35-42: subscription manager and associated database assures coordinated update, messaging among service provider, partner and subscriber).

- i. Regarding claim 6, Aoki shows further including: configuring the definition of "legal standards" or "best practices"; querying in real time whether sending a particular e-mail conforms to "legal standards" or "best practices" for each e-mail address (column 1, lines 32-39: legitimate subscription-type messages; column 2, lines 28-36: invention in interactive real time messaging service; column 3, lines 4-21: legitimate recurring messages; column 3, lines 22-29 and 52-65: subscription manager process incoming messages and determine whether an individual message matches the filtering rules stored in a subscription database accessible to a message service; column 6, lines 35-42: subscription manager and associated database assures coordinated update, messaging among service provider, partner and subscriber; line 40-column 6, line 3: double opt-out confirmation on canceling subscription).
- j. Regarding claim 7, Aoki shows further including: utilizing the database and processing mechanisms to modify, update, or delete opt-out or unsubscribe information (column 1, lines 58-63: maintain and update subscription database; column 7, lines 34-38: subscription cancellation form).
- k. Regarding claim 8, Aoki shows further including: utilizing the database and processing mechanisms for real-time "DO NOT E-MAIL" queries (column 5, lines 11-26: subscription database and rule database used in screening out unauthorized broadcast messages).
- l. Regarding claim 9, Aoki shows further including: utilizing the database and processing mechanisms to synchronize information with external sources of opt-out or unsubscribe information (column 3, lines 42-51: service provider provide



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- subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users).
- m. Regarding claim 10, Aoki shows further including: utilizing the database and processing mechanisms to synchronize information with external recipients of opt-out or unsubscribe information (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users).
- n. Regarding claim 11, Aoki shows further including: utilizing the database and processing mechanisms to collect, store, process and distribute opt-in or subscription information (column 3, lines 42-51: service provider provide subscription-type message; column 1, lines 58-63: maintain and updating subscription database; column 2, lines 4-11: maintain and updating subscription among message service provide, message source partner and recipient users; column 7, lines 34-38: subscription start form).
- o. Regarding claim 12, Aoki shows further including: utilizing the database and processing mechanisms for e-mail list "cleaning" of addresses to be removed (column 6, lines 35-42: subscription manager and associated database assures coordinated update, messaging among service provider, partner and subscriber; column 7, lines 34-38: subscription cancellation form).

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- p. Claim 13 is of the same scope as claim 1. It is rejected for the same reasons as for claim 1.
- q. Regarding claim 14, Aoki shows wherein said opt-out or unsubscribe system is a sub-system of a system which also sends e-mail (Fig. 1, items 22 and 32: mail server, mail subscription manager; column 5, lines 11-26: send outbound messages via 32 and 22).
- r. Regarding claim 15, Aoki shows wherein said opt-out or unsubscribe system is a sub-system of a system which also provides e-mail list management functions (Fig. 1, items 22 and 32: mail server, mail subscription manager; column 5, lines 27-39: listing of approved message sources maintained for each individual user by subscription manager).
- s. Claims 16-26 are of the same scope as claims 2-12. These are rejected for the same reasons as claims 2-12.
- t. Claims 27-38 are of the same scope as claims 1-12. These are rejected for the same reasons as for claims 1-12 with Tripp's showing of agent configured to exclude some portion of a site of sites.
- u. Regarding claim 39, Tripp shows wherein the permission spectrum has a first limit, a second limit, and an intermediate gradient between the first limit and the second limit, such that: the entity sends unlimited information to an email address that is fit at the first limit; the entity sends no information to an email address that is fit at the second limit; the entity sends limited information to an email address that is fit within the intermediate gradient, wherein the limited information is derived based on the processed contextual information (in light of Fig. 1 and 5<sup>th</sup> paragraph on page 9

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through 2<sup>nd</sup> paragraph on page 10 of applicant's specification; paragraphs 96-98:

dynamic rating/ranking based on contextual information for web pages opt-in/opt-out

request via email).

Together Aoki and Tripp disclosed all limitations of claims 1-39. Claims 1-39 are rejected

under 35 U.S.C. 103(a).

***Response to Arguments***

6. Applicant's arguments filed on 09/17/2008 with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

- a. Applicant has amended independent claims with the limitations of “fit the e-mail address within a permission spectrum based on the processed contextual information”; “wherein the entity sends information to the e-mail address based on the permission level indicated by the permission spectrum” and “wherein the user is provided with a configurable opt-out link to provide the contextual information”. Examiner has reviewed the limitations in light of applicant's original specification and claim set and found Fig. 1 and 5<sup>th</sup> paragraph on page 9 through 2<sup>nd</sup> paragraph on page 10 of the specification contain description related the limitations. Examiner has searched and found that Tripp seems to contain a similar feature in the general art of opt-out subscription (paragraphs 93 through paragraph 98). Claim rejections are updated with the amended claim changes and cited references from Tripp on the limitations.

***Remarks***

7. The following pertaining arts are discovered and not used in this office action. Office reserves the right to use these arts in later actions.

- a. Melet et al. (US 6615238 B1) Evolving interactive dialog box for an internet web page
- b. Wachtel (US 6847974 B2) Method and apparatus for intelligent data assimilation
- c. Carty et al. (US 7043497 B1) System and method for capturing and storing web site visitor profile information in a data warehouse
- d. Seibel et al. (US 7043531 B1) Web-based customer lead generator system with pre-emptive profiling
- e. Adler et al. (US 7069427 B2) Using a rules model to improve handling of personally identifiable information
- f. Rounthwaite et al. (US 7219148 B2) Feedback loop for spam prevention
- g. Spitz et al. (US 20030114157 A1) Systems, methods, and computer program products for registering wireless device users in direct marketing campaigns

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peling A. Shaw whose telephone number is (571) 272-7968. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peling A Shaw/  
Examiner, Art Unit 2444